

Application No. 10/802,588
Amendment Dated February 3, 2005
Reply to Office Action dated December 16, 2004

REMARKS

By this Amendment, Claims 2-4 are amended and Claims 1 and 5 were previously cancelled.

Claims 2, 3 and 4 are pending.

The Examiner has rejected Claims 2-3 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,497,522 (Chen, Chin-Chuan, hereinafter "Chen") in view of U.S. Patent No. 6,282,996 (Berg et al., hereinafter "Berg"). In particular, the Examiner states that:

Chen discloses a pair of pliers having a pair of jaws, each of which has an outside surface, wherein at least one of the outside surfaces comprises a file. Chen does not disclose that the file is detachable or that the pliers has an aperture at one end. Berg et al. discloses a pair of multi-purpose pliers having a detachable file, and an aperture so as to respectively provide flexibility in configuring the elements that comprise the pliers and releasably secure the file. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have made the Chen pliers to have a detachable file, and make an aperture in the pliers as taught by Berg et al. so as to respectively provide flexibility in configuring the elements that comprise the pliers and releasably secure the file.

Applicant respectfully disagrees for the following reasons.

Berg discloses a multipurpose locking pliers 30 which comprises, among other things, a combined file and screwdriver blade 194 which can be pivoted about a blade shaft 42¹. However, there is no teaching or suggestion that the combined file and screwdriver blade 194 is *detachable* from the multipurpose tool 30 itself. Furthermore, the blade 194 is only pivotable about a *handle* shaft, i.e., it is not even pivotable about a *jaw* shaft. Thus, the only incentive to combine Chen and Berg is to include a file tool (194 in Berg) with the tools 43 or 52 of Chen (see Fig. 1 of Chen). But

¹Berg, col. 11, lines 6-8.

adding a file tool to Chen from Berg would still not result in the present invention of a *detachable* file releasably coupled to one surface of at least one *jaw*. To that end, Claim 2 has been amended to more clearly specify this feature. Thus, Applicant respectfully submits that Claim 2, as amended, is patentable over the art of record and respectfully requests that the §103(a) rejection be withdrawn.

With particular regard to Claim 3, it is dependent upon Claim 2 and is patentable for the same reasons. Furthermore, Claim 3 specifies an “aperture at one end for receiving a releasable coupling means to releasably fasten one end of said file,” Berg does not teach nor suggest a releasable coupling means. As clearly shown in Berg, the blade shaft 42 is an anchor pin that does not provide for any releasable fastening of the blade 194 to the tool 30. In particular, there does not appear to be any means to release the shaft 42 from the handle in order to release the blade 194 from the tool 30. In contrast, the present invention comprises a releasable coupling means 30 (e.g., screw, bolt, etc.)² that allows the file 24 to be released from the pliers jaw 26A (or 26B) and a new one installed. Claim 3 has also been further amended to be consistent with the amendments of Claim 2. Thus, Applicant respectfully submits that Claim 3, as amended, is patentable over the art of record and respectfully requests that the §103(a) rejection be withdrawn.

The Examiner has rejected Claim 4 under 35 U.S.C. §103(a) as being unpatentable over Chen in view of Berg and in further view of U.S. Patent No. 6,009,583 (Swanstrom, Jr., hereinafter “Swanstrom”). In particular, the Examiner states that:

²Present application, Fig. 2 and p. 3, line 2.

Chen as modified is described above. The modified Chen does not specifically disclose a groove. Swanstrom discloses a pair of pliers comprising a groove for receiving additional elements. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have made the pliers of the modified Chen pliers to have a groove as taught by Swanstrom, Jr. for receiving additional elements.

Applicant respectfully disagrees for the following reasons.

The only grooves mentioned in Swanstrom are grooves (48a/48b or 248a/248b)³ positioned in a cap 47 for holding the handles of the Swanstrom pliers-knife 10 closed or the V-shaped edges of the inside blade surfaces of the jaws (60'/62' or 76a''/76b)⁴ for locking the inside blade surfaces together to form the knife. There is no teaching or suggestion whatsoever in Swanstrom of using a groove, on the *outside surface of the jaws portion of the pliers/knife* for releasably securing a detachable file, or any member, to the outside surface of the jaws portion of the pliers/knife. There does not appear to be any motivation to combine Swanstrom with Chen and Berg other than the fact that the word "groove" is used in Swanstrom and other than using the invention of the present application as a template⁵. Furthermore, the fact that the blade 194 of Berg is a combined file and screwdriver would require that the screwdriver end of the blade 194 be clear of the distal end of the pliers jaw 34/36 in order to function, e.g., attempting to secure the screwdriver end of the blade 194

³Swanstrom, col. 5, line 32 to col. 6, line 12; and col. 8, lines 1-26.

⁴Swanstrom, col. 4, lines 9-21; and col. 7, lines 5-14.

⁵ Applicant reminds the Examiner that the mere fact that the references cited may be modified or even combinable does not allow the PTO to meet its burden absent a suggestion in the cited art of the desirability of the modification or combination. Moreover, the PTO may not "use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." In re Fritch, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992).

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into a groove would eliminate the screwdriver aspect. Thus, even if one skilled in the art were to combine Berg with Chen⁶, as suggested by the Examiner, would result in securing the screwdriver end of the blade 194 to the Chen pliers jaw, thereby defeating the purpose of the combined file and screwdriver blade 194. Claim 4 has also been further amended to be consistent with the amendments of Claims 2 and 3. Thus, Applicant respectfully submits that Claim 4, as amended, is patentable over the art of record and respectfully requests that the §103(a) rejection be withdrawn.

To further counter the §103(a) obviousness rejection, Applicant would like to bring to the Examiner's attention that he has received several sales orders for the invention of the present invention that is marketed as a fishing tool that can be used as a pliers to remove fish hooks with the added feature of being able to sharpen these same hooks using the replaceable file.

For at least the reasons set forth above, it is respectfully submitted that the above-identified application is in condition for allowance. Favorable reconsideration and prompt allowance of the claims are respectfully requested.

⁶Applicant earlier stated that even combining these two references would still not result in the invention of the present application.

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Should the Examiner believe that anything further is desirable in order to place the application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned attorney at the telephone number listed below.

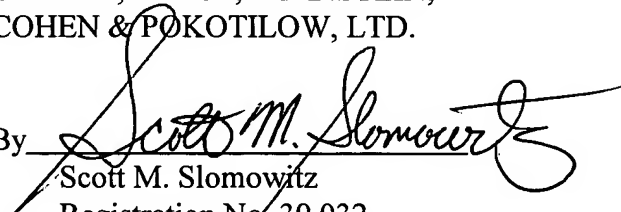
Respectfully submitted,

CAESAR, RIVISE, BERNSTEIN,
COHEN & POKOTILOV, LTD.

February 3, 2005

Please charge or credit our Account
No. 03-0075 as necessary to effect
entry and/or ensure consideration of
this submission.

By


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